UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,506	02/13/2004	Lee S. Weinblatt	5264-31CIP	8900

7590 07/21/2009

COHEN, PONTANI, LIEBERMAN & PAVANE
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER	
SHEPARD, JUSTIN E	
ART UNIT	PAPER NUMBER
2424	
MAIL DATE	DELIVERY MODE
07/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/779,506	WEINBLATT ET AL.	
	Examiner	Art Unit	
	Justin E. Shepard	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Page 10, last paragraph:

The examiner accepts that the reproduction equipment constitutes an apparatus that is tied to the method claims. Therefore the claims are considered statutory and the 101 rejection is withdrawn.

Page 11, Double Patenting Section:

The examiner accepts that application 10/080,949 has been abandoned and therefore the double patenting rejection is withdrawn.

Applicant's remaining arguments filed 6/1/09 have been fully considered but they are not persuasive.

Page 14, first paragraph:

The applicant argues that as the audible signal generated in Yamamoto is not generated in response to the received broadcast signal including the supplementary, program-related data signal and therefore does not meet the limitation found in the claim. The examiner agrees that the audible signal is generated by another device, such as an email device, but this alone does not mean that the limitation is not met. Yamamoto teaches that a coupon can be received by a set top box (column 2, lines 13-24; column 3, lines 14-19), and based on the received coupon's embedded expiry date an email reminder can be sent which contains an audible signal (column 8, line 62 to

column 9, line 6). It is the interpretation of this section that as the coupon is received in the broadcast signal and the expiry data stored in the program related data (the coupon) causes the audible signal to be emitted, and that this meets the limitation found in the claim. The examiner suggests that the applicant modifies the limitation to read that the audible signal is sounded at the time that the coupon is received or by the receiving device, or by some similar matter, if there is support in the specification for the amendment. This would get around the Yamamoto reference and cause the examiner to perform an additional search and move prosecution forward.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 12, 14-19, 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman in view of Chang in view of Yamamoto.

Referring to claim 1, Holman discloses an interactive method for generating a supplementary, program-related output (figure 1), comprising:

obtaining a programming signal (column 6, lines 5-12);

obtaining a supplementary, program-related data signal (column 9, lines 10-32);

combining said programming signal and said supplementary, program-related data signal into a broadcast signal (column 9, lines 10-32);

broadcasting said broadcast signal from a program signal source (figure 2, part 33);

receiving said broadcast signal (column 6, lines 5-12);

performing said programming signal of the received broadcast signal with reproduction equipment for an audience (column 6, lines 5-12);

storing said supplementary, program-related data signal of the received broadcast signal on a storage media (column 6, lines 20-36);

enabling retrieval of rewards data corresponding to products or services by accessing said stored supplementary, program-related data signal from said storage media (column 6, lines 39-64); and

selecting a reward from said retrieved rewards data (figure 1).

Holman does not disclose a method wherein the storage media is a portable storage media; and

generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal.

In an analogous art, Chang teaches a method wherein the storage media is a portable storage media (paragraph 23).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the portable storage media taught by Chang to the method disclosed by Holman. The motivation would have been to enable the available storage to be expanded by purchasing more memory cards.

Holman and Chang do not disclose a method for generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal.

In an analogous art, Yamamoto teaches a method for generating an audible signal in response to the received broadcast signal including the supplementary, program-related data signal (column 8, line 62 to column 9, line 6).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the audio signal output taught by Yamamoto to the method disclosed by Holman and Chang. The motivation would have been to enable viewers that have the television on the background to still be alerted to the presence of the coupon.

Claims 14, 21, 22, and 23 are rejected on the same grounds as claim 1.

Referring to claim 2, Holman discloses an interactive method of claim 1, wherein said supplementary, program- related data signal includes all data necessary to produce a human-perceptible output (figures 1 and 5).

Claim 15 is rejected on the same grounds as claim 2.

Referring to claim 3, Holman discloses an interactive method of claim 2, further comprising the step of authorizing eligibility for said selected reward based on said stored supplementary, program-related data signal (column 16, line 55 to column 17, line 6).

Claim 16 is rejected on the same grounds as claim 3.

Referring to claim 4, Holman discloses an interactive method of claim 3, further comprising the step of storing validation indicia on said portable storage media, said validation indicia corresponding to a validation of the selected reward (column 16, line 55 to column 17, line 6).

Claim 17 is rejected on the same grounds as claim 4.

Referring to claim 5, Holman discloses an interactive method of claim 4, wherein said selecting step comprises displaying said retrieved rewards data on a human-perceptible display (figure 1).

Claim 18 is rejected on the same grounds as claim 5.

Referring to claim 6, Holman discloses an interactive method of claim 5, wherein said human-perceptible output produced from said reward data signal is a discount coupon (column 6, lines 20-38).

Referring to claim 7, Holman discloses an interactive method of claim 4, further comprising the step of displaying at least a portion of said stored supplementary, program-related data on a display device remote from said reproduction equipment (column 8, lines 45-46).

Claim 19 is rejected on the same grounds as claim 7.

Referring to claim 8, Holman discloses an interactive method of claim 7, wherein said authorizing eligibility step comprises a step of comparing said stored supplementary, program-related data to said selected reward to determine compatibility and, if compatibility, is determined, storing said validation indicia on said portable storage media (column 16, line 55 to column 17, line 6).

Referring to claim 9, Holman discloses an interactive method of claim 8, wherein said authorizing eligibility step comprises a step of comparing said stored supplementary, program-related data to said selected reward to determine compatibility and, if compatibility is determined, printing a discount coupon corresponding to said selected reward (column 16, line 55 to column 17, line 6; column 8, lines 45-46).

Referring to claim 12, Holman discloses an interactive method of claim 9, further comprising the step of deleting data from said portable storage media for preventing access to multiple occurrences of said selected reward upon one of the printing of a discount coupon and the storing of the validation indicia (column 16, line 55 to column 17, line 6; column 8, lines 45-46; column 13, lines 52-57; column 8, lines 45-46).

Claims 10, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman, Chang, and Yamamoto as applied to the claims above, and further in view of Ben-David.

Referring to claim 10, Holman, Chang, and Yamamoto do not disclose an interactive method of claim 7, wherein said remote display device comprises a personal computing device.

In an analogous art, Ben-David teaches an interactive method of claim 7, wherein said remote display device comprises a personal computing device (paragraph 116).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the PDA taught by Ben-David to the method disclosed by Holman, Chang, and Yamamoto. The motivation would have been to enable the user to carry a plurality of coupons without the bulk of carrying paper coupons.

Claim 20 is rejected on the same grounds as claim 10.

Referring to claim 11, Holman, Chang, and Yamamoto do not disclose an interactive method of claim 7, wherein said remote display device comprises a public computing device.

In an analogous art, Ben-David teaches an interactive method of claim 7, wherein said remote display device comprises a public computing device (paragraph 116).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the portable computing unit taught by Ben-David to the method disclosed by Holman, Chang, and Yamamoto. The motivation would have been to enable the user to carry a plurality of coupons without the bulk of carrying paper coupons.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holman, Chang, and Yamamoto as applied to claim 12 above, and further in view of Reams.

Referring to claim 13, Holman, Chang, and Yamamoto do not disclose an interactive method of claim 12, wherein said selecting step comprises using said stored supplementary, program-related data signal to access information through the Internet.

In an analogous art, Reams teaches an interactive method of claim 12, wherein said selecting step comprises using said stored supplementary, program-related data signal to access information through the Internet (figure 1; paragraph 10).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the internet download coupon taught by Reams to the method disclosed by Holman, Chang, and Yamamoto. The motivation would have been to enable a more complicated coupon than transmission over a low bandwidth channel such as the VBI would have allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit 2424

JS